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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RAJENDRA K. SHAH and JERRY D. RYAN

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Appeal 2009-005920  
Application 10/752,626  
Technology Center 3700

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Decided: December 4, 2009

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Before LINDA E. HORNER, JOHN C. KERINS, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

SILVERBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Rajendra K. Shah et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 4, 5, 7-11, 16, 17 and 19-29<sup>1</sup>. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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<sup>1</sup> The rejections of claims 3, 6, 12-15 and 18 have been withdrawn (Ans. 3).

## SUMMARY OF DECISION

We REVERSE.

## THE INVENTION

The Appellants' claimed invention is directed to an HVAC system wherein several interconnected units communicate control signals over a communication bus (Spec. 1: ¶ [0001]).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An HVAC system comprising:  
a thermostat incorporating a central control,  
and operator input switches;  
a data bus communicating control signals  
from said central control to an indoor HVAC unit,  
said indoor HVAC unit being operable to provide a  
heating function to air within an environment, said  
indoor HVAC unit being provided with a control  
that directly controls said indoor HVAC unit, and  
which receives control signals on said data bus  
from said central control.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kobayashi	US 4,811,897	Mar. 14, 1989
Jurewicz	US 5,323,385	Jun. 21, 1994

The following rejections<sup>2</sup> by the Examiner are before us for review:

1. Claims 1, 2, 5, 8, 9 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kobayashi.
2. Claims 4, 10, 11, 16, 17 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi.
3. Claims 23-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of official notice.
4. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Jurewicz.

#### ISSUE

The issue before us is whether the Examiner erred in finding that Kobayashi describes an indoor HVAC unit being operable to provide a heating function as called for in independent claims 1, 10 and 22 (Reply Br. 1-3; App. Br. 6, 8).

#### ANALYSIS

*Regarding claims 1 and 22:* Appellants contend that in Kobayashi, the dampers 9 control how much heated air may flow into the environment, but they do not provide a heating function to that air as called for in claims 1 and 22 (Reply Br. 2, App. Br. 6).

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<sup>2</sup> The following rejections under 35 U.S.C. § 103(a) as set forth in the Final Rejection mailed December 31, 2005 (Final Rejection 3, 4) have been withdrawn (Ans. 3, 8): (1) the rejection of claims 3 and 12-14 over Kobayashi in view of Otsuka; (2) the rejection of claims 6 and 18 over Kobayashi in view of Munson; and (3) the rejection of claim 15 over Kobayashi in view of Jurewicz.

The Examiner found that in Kobayashi (1) dampers 9 are an indoor HVAC unit (Ans. 6), and (2) “the control of airflow of heated air provided by dampers 9 is a ‘heating function’ for the air being passed into the environment.” (Ans. 3, 6) (emphasis added).

Kobayashi describes dampers 9 as a way of controlling the flow of air into a particular room (*passim*, fig. 5). Kobayashi’s description of dampers 9 is consistent with the ordinary meaning of the word “damper,” which includes “[a]n adjustable plate, as in the flue of a furnace or stove, for controlling the draft.” THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE (4<sup>th</sup> ed. 2000).

As Kobayashi’s dampers 9 only provide an opening for passing along already-heated air<sup>3</sup> to an environment, we agree with Appellants that Kobayashi’s dampers 9 do not provide a heating function to the air in that environment. Since Kobayashi’s dampers 9 do not provide a heating function to the air, Kobayashi does not describe an indoor HVAC unit operable to provide a heating function as called for in independent claims 1 and 22.

Accordingly, Kobayashi does not anticipate independent claims 1 and 22. For the same reasons, Kobayashi does not anticipate claims 2, 5, 8 and 9, which depend from claim 1.

*Regarding claim 10:* Appellants state that claim 10 is improperly rejected for the same reasons as claim 1. (App. Br. 8). Accordingly, we find that Appellants repeat their contention regarding claim 1 for claim 10, that is, in Kobayashi, the dampers 9 control how much heated air may flow into

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<sup>3</sup> In Kobayashi, the air is heated by an outdoor heat source device 17 (e.g., a heat pump). Kobayashi, col. 4, ll. 17-20 and col. 5, ll. 30-36; figs. 3, 5.

the environment, but they do not provide a heating function to that air as called for in claim 10.

The Examiner's conclusion of obviousness regarding independent claim 10 (Ans. 4, 7) was premised on his previous findings that in Kobayashi (1) dampers 9 are an indoor HVAC unit, and (2) "the control of airflow of heated air provided by dampers 9 is a 'heating function' for the air being passed into the environment."

As we previously found, Kobayashi's dampers 9 do not provide a heating function to the air. Therefore, Kobayashi's dampers 9 do not describe an indoor HVAC unit operable to provide a heating function as called for in independent claim 10.

The Examiner has not provided any rationale why the provision of Kobayashi's dampers 9 being operable to provide a heating function as called for claim 10 would have been obvious to a person having ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Further, it is not clear to us why the provision of Kobayashi's dampers 9 being operable to provide a heating function as called for claim 10 would have been obvious to a person having ordinary skill in the art.

We thus conclude that the Examiner also erred in rejecting claim 10 as being unpatentable over Kobayashi. For the same reasons, we thus conclude that the Examiner also erred in rejecting claims 4, 11, 16, 17 and 19-21, which depend from claims 1 and 10, respectively.

*Regarding claims 7 and 23-29:* The Examiner has not relied on Jurewicz or official notice for any teaching that would remedy the deficiency in Kobayashi (Ans. 4-5). We thus conclude that the Examiner also erred in

rejecting claim 7 over Kobayashi in view of Jurewicz, and erred in rejecting claims 23-29 over Kobayashi in view of official notice.

### CONCLUSION OF LAW

Appellants have established that the Examiner erred in finding that Kobayashi describes an indoor HVAC unit being operable to provide a heating function as called for in independent claims 1, 10 and 22.

### DECISION

The decision of the Examiner to reject claims 1, 2, 4, 5, 7-11, 16, 17 and 19-29 is reversed.

### REVERSED

mls

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